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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Benny et al.	:	Frejd, Russell Warren
Serial No.: 09/875,865	:	Group Art Unit: 2128
Filed: June 7, 2001	:	
	:	IBM Corporation
Title: ENTERPRISE SERVICE	:	Intellectual Property Law
DELIVERY TECHNICAL	:	11400 Burnet Road
ARCHITECTURE	:	Austin, Texas 78758

SECOND APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I. **REAL PARTY IN INTEREST**

The real party in interest is International Business Machines Corporation, which is the assignee of the entire right, title and interest in the above-identified patent application.

II. **RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences known to Appellants, Appellants' legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. **STATUS OF CLAIMS**

Claims 25-30 are pending in the Application. Claims 1-24 were cancelled. Claims 25-30 stand rejected. Claims 25-30 are appealed.

IV. STATUS OF AMENDMENTS

Appellants have not submitted any amendments following receipt of the final office action with a mailing date of November 20, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 25:

In one embodiment of the present invention, a method for using an enterprise service delivery technical model to develop a technical framework to provide Systems Management services to a customer, comprising the step of identifying a Systems Management solution scope specific to an information technology environment of the customer. Specification, page 32, lines 1-5; Figure 2, step 202. The method further comprises inventorying existing information technology and Systems Management components supporting the information technology environment of the customer that are within the Systems Management solution scope. Specification, page 32, lines 5-9; Figure 2, step 203. The method further comprises mapping the existing information technology and Systems Management components supporting the information technology environment of the customer to architectural building blocks of a predetermined enterprise service delivery technical model. Specification, page 32, lines 10-21; Figure 2, step 204. The method further comprises identifying which architectural building blocks of the predetermined enterprise service delivery technical model are required to deliver the Systems Management services to the customer in accordance with the Systems Management solution scope. Specification, page 33, lines 6-13. The method further comprises mapping the inventoried existing information technology components that were mapped to the architectural building blocks of the predetermined enterprise service delivery technical model to the architectural building blocks of the predetermined enterprise service delivery technical model that were identified as required to deliver the Systems Management services in accordance with the Systems Management solution scope, this mapping step resulting in a list of design objects and relationships between

the design objects that will deliver the Systems Management services in accordance with the Systems Management solution scope. Specification, page 33, lines 14-22; Specification, page 34, line 15 – page 35, line 2.

Independent Claim 28:

In one embodiment of the present invention, a computer program product for storage on a computer readable medium, the computer program product operable for creating an information technology technical architecture comprising the program step of identifying a Systems Management solution scope specific to an information technology environment of the customer. Specification, page 32, lines 1-5; Specification, page 36, line 18 – page 37, line 11; Figure 2, step 202. The computer program product further comprises the program step of inventorying existing information technology and Systems Management components supporting the information technology environment of the customer that are within the Systems Management solution scope. Specification, page 32, lines 5-9; Specification, page 36, line 18 – page 37, line 11; Figure 2, step 203. The computer program product further comprises the program step of mapping the existing information technology and Systems Management components supporting the information technology environment of the customer to architectural building blocks of a predetermined enterprise service delivery technical model. Specification, page 32, lines 10-21; Specification, page 36, line 18 – page 37, line 11; Figure 2, step 204. The computer program product further comprises the program step of identifying which architectural building blocks of the predetermined enterprise service delivery technical model are required to deliver the Systems Management services to the customer in accordance with the Systems Management solution scope. Specification, page 33, lines 6-13; Specification, page 36, line 18 – page 37, line 11. The computer program product further comprises the program step of mapping the inventoried existing information technology components that were mapped to the architectural building blocks of the predetermined enterprise service delivery technical model to the architectural building blocks of the predetermined enterprise service delivery

technical model that were identified as required to deliver the Systems Management services in accordance with the Systems Management solution scope, this mapping step resulting in a list of design objects and relationships between the design objects that will deliver the Systems Management services in accordance with the Systems Management solution scope. Specification, page 33, lines 14-22; Specification, page 34, line 15 – page 35, line 2; Specification, page 36, line 18 – page 37, line 11.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. Claims 25-30 stand rejected under obviousness-type double patenting as being unpatentable over claims 22-25 of U.S. Patent Application No. 09/876,090.

VII. ARGUMENT

A. Claims 25-30 are not properly rejected under obviousness-type double patenting.

The Examiner has provisionally rejected claims 25-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-25 of copending U.S. Patent Application No. 09/876,090. Office Action (8/8/2007), page 3. According to M.P.E.P. §804, since both of these applications were filed on the same day, the Examiner needs to determine which application claims the base invention and which application claims the improvement (added limitations). Further, according to M.P.E.P. §804, the obviousness-type double patenting rejection in the base application can be withdrawn without a terminal disclaimer, while the obviousness-type double patenting rejection in the improvement application cannot be withdrawn without a terminal disclaimer. On October 31, 2007, Examiner Frejd informed Appellants' Attorney, Bobby Voigt, that U.S. Patent Application No. 09/876,090 is considered the "base application" and that the present application is considered the "improvement application." Appellants respectfully contest the assertion that claims 25-30 are not patentably distinct from claims 22-25 of copending U.S. Patent Application No. 09/876,090 and therefore assert that claims 25-30 are not properly rejected under obviousness-type double patenting.

In determining whether a non-statutory basis exists for a double patenting rejection, the first question to be asked is—does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent¹? M.P.E.P. §804. A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the non-obviousness requirement of 35 U.S.C. §103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 U.S.P.Q. 29 (C.C.P.A. 1967); M.P.E.P. §804. Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 U.S.P.Q. 645 (Fed. Cir. 1985).

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. §103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. §103 are employed when making an obvious-type double patenting analysis. M.P.E.P. §804. However, the Examiner has not made any such inquiry. The Examiner has not made any factual inquiries (1) to determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue; (2) to determine the differences between the scope and content of the patent claim and the prior art as determined in (1) and the claim in the application at issue; (3) to determine the level of ordinary skill in the art; and (4) to evaluate any objective indicia of non-obviousness. M.P.E.P. §804. Any obviousness-type double patenting rejection should make clear the differences between the inventions defined by the conflicting claims—a claim in the patent compared to a claim in the application. M.P.E.P. §804. Further, any obviousness-type double patenting rejection should

¹ Appellants note that where "patent" is referred to herein that it corresponds to the other pending patent application (U.S. Patent Application No. 09/876,090).

include reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent. M.P.E.P. §804. The Examiner has not made clear the differences between the inventions claimed in the application and the claims in U.S. Patent Application Serial No. 09/876,090.

For example, how is the limitation of "inventorying existing information technology and Systems Management components supporting the information technology environment of the customer that are within the Systems Management solution scope" as recited in claim 25 of the present application an obvious variation of a claim in U.S. Patent Application Serial No. 09/876,090? In another example, how is the limitation of "identifying which architectural building blocks of the predetermined enterprise service delivery technical model are required to deliver the Systems Management services to the customer in accordance with the Systems Management solution scope" as recited in claim 25 of the present application an obvious variation of a claim in U.S. Patent Application Serial No. 09/876,090?

Consequently, in view of the foregoing, the Examiner has not provided a basis for an obviousness-type double patenting rejection of claims 25-30. Thus, the rejections of claims 25-30 under obviousness-type double patenting are improper.

VIII. CONCLUSION

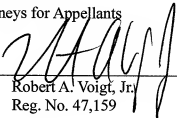
For the reasons noted above, the rejections of claims 25-30 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 25-30.

Respectfully submitted,

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CLAIMS APPENDIX

25. A method for using an enterprise service delivery technical model to develop a technical framework to provide Systems Management services to a customer, comprising the steps of:

identifying a Systems Management solution scope specific to an information technology environment of the customer;

inventorying existing information technology and Systems Management components supporting the information technology environment of the customer that are within the Systems Management solution scope;

mapping the existing information technology and Systems Management components supporting the information technology environment of the customer to architectural building blocks of a predetermined enterprise service delivery technical model;

identifying which architectural building blocks of the predetermined enterprise service delivery technical model are required to deliver the Systems Management services to the customer in accordance with the Systems Management solution scope; and

mapping the inventoried existing information technology components that were mapped to the architectural building blocks of the predetermined enterprise service delivery technical model to the architectural building blocks of the predetermined enterprise service delivery technical model that were identified as required to deliver the Systems Management services in accordance with the Systems Management solution scope, this mapping step resulting in a list of design objects and relationships between the design objects that will deliver the Systems Management services in accordance with the Systems Management solution scope.

26. The method as recited in claim 25, wherein the architectural building blocks and defined relationships between the architectural building blocks are a function of a set of predefined principles and key requirements.

27. The method as recited in claim 25, wherein relationships between the architectural building blocks are arranged in predefined logical levels.

28. A computer program product for storage on a computer readable medium, the computer program product operable for creating an information technology technical architecture comprising the program steps of:

- identifying a Systems Management solution scope specific to an information technology environment of the customer;

- inventorying existing information technology and Systems Management components supporting the information technology environment of the customer that are within the Systems Management solution scope;

- mapping the existing information technology and Systems Management components supporting the information technology environment of the customer to architectural building blocks of a predetermined enterprise service delivery technical model;

- identifying which architectural building blocks of the predetermined enterprise service delivery technical model are required to deliver the Systems Management services to the customer in accordance with the Systems Management solution scope; and

- mapping the inventoried existing information technology components that were mapped to the architectural building blocks of the predetermined enterprise service delivery technical model to the architectural building blocks of the predetermined enterprise service delivery technical model that were identified as required to deliver the Systems Management services in accordance with the Systems Management solution scope, this mapping step resulting in a list of design objects and relationships between the design objects that will deliver the Systems Management services in accordance with the Systems Management solution scope.

29. The computer program product as recited in claim 28, wherein the architectural building blocks and defined relationships between the architectural building blocks are a function of a set of predefined principles and key requirements.

30. The computer program product as recited in claim 28, wherein relationships between the architectural building blocks are arranged in predefined logical levels.

EVIDENCE APPENDIX

No evidence was submitted pursuant to §§1.130, 1.131, or 1.132 of 37 C.F.R. or of any other evidence entered by the Examiner and relied upon by Appellants in the Appeal.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings to the current proceeding.

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